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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/803,419	03/18/2004	Daniel D. Friel SR.	FRIEL-105	5873
7590	10/19/2004			
Connolly Bove Lodge & Hutz LLP				
P.O. Box 2207				
Wilmington, DE 19899-2207				
			EXAMINER	
			SHAKERI, HADI	
		ART UNIT	PAPER NUMBER	
		3723		

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/803,419	Applicant(s) FRIEL ET AL.	
	Examiner Hadi Shakeri	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
 4a) Of the above claim(s) 4,5,14-38 and 40-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-13,39 and 44-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Election/Restrictions

1. Claims 4, 5, 14-38 and 40-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 09072004.

Applicant's election with traverse of Group I in the reply filed on 09072004 is acknowledged. The traversal is on the ground(s) that Group I are part of combination of Group II and that if Group I is found to be allowable then claims of Group II should be examined as well. This is not found persuasive because with regards to the restriction between Group I and II, as indicated in the previous office action, these groups are related as combination and subcombination, however, restriction in this relationship is proper if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the sharpener as claimed does not require the predetermined angle B. The subcombination has separate utility such as conditioning. But with regards to election of species, as indicated in the previous office action, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the aligned rods or rollers as claimed in the new claim 51, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. Applicant is requested to delete the reference to the US class and subclasses for the references cited, since these designations are not necessarily permanent and may change in time.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-13, 39, 44-52 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 recites the limitation "two edge facets" in line 6. There is insufficient antecedent basis for this limitation in the claim. Same rejection applies to claims 13, 44 and 53.
7. Claim 39 recites the limitation "located at least one on each side of the edge" in lines 8 and 9. The elected species, i.e., Figs. 13-16A does not disclose a conditioning apparatus wherein more than one hardened surfaces or conditioning elements (13) are located one at each side of the blade or the edge. The two hardened surface or conditioning elements (13) that are disclosed are both located on one side of the edge. 112 1st paragraph rejection is not applied, at this point, since the deficiencies appear to be more of clarity than enablement.
8. Claim 44 recites the limitation "to guide the lower portion of one or more of the facets" in lines 9 and 10, rendering the claim indefinite, since it appears that the apparatus is recited to be capable of also guiding only one of the two facets, earlier claimed in line 6, i.e., guiding one facet and not the other.
9. Also regarding the independent claims, e.g., claim 1, line 10, "the hardened surface", "the plane" and line 12, "the plane of contact" should be changed to, --a hardened surface--, --a plane--...
10. Regarding claims 7 and 8, "its axis" in line 4 and 5 respectively, renders the claims indefinite for not positively reciting the axis, i.e., what axis?

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11. Regarding claims 9 and 10, the language as written renders the claims indefinite, since it is unclear what elements are being claimed. The terminologies, e.g., "brake mechanism" is not from the specification as originally filed. Is applicant claims the O-ring 21 or a spring not shown? Whereas "adjustable" as recited in claim 11, is supported to define rotate, raise or lower, the subject matter in claims 9 and 10 is not clear.

12. Claim 48 recites the limitation "said single guide plane" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

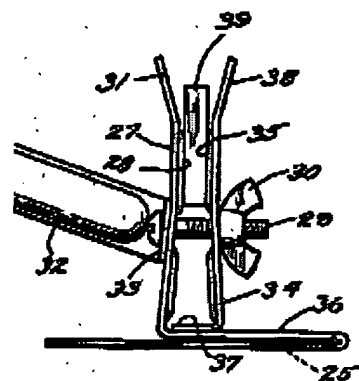
13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 2, 13, 44, 46 and 53 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Brinkley (2,559,273).

Brinkley discloses all of the limitations of claims 1, 13, 44, and 53, i.e., a knife conditioner, comprising a guide (31, 38) and an object having hardened surface (39) and a method for conditioning using the apparatus. Note that lacking any structures to distinguish between "sharpening" and "conditioning" the prior art as cited is considered to meet the recitation.

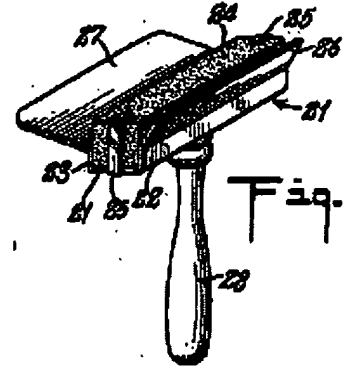


Regarding claims 2, 46 and 50, Brinkley meets the limitations, e.g., handle (32); support member (27, 25, 36) and guide (38) pivotally mounted to the support at (34, 37), and adjusting structure (29, 30).

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15. Claims 1, 2, 13, 44, 46 and 53 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Andrews (2,645,066).

Andrews discloses all of the limitations of claims 1, 13, 44, and 53, i.e., a knife conditioner, comprising a guide (26) and an object having hardened surface (24) and a method for conditioning using the apparatus. Note that lacking any structures to distinguish between "sharpening" and "conditioning" the prior art as cited is considered to meet the recitation.



Regarding claims 2, and 46, Andrews meets the limitations, e.g., handle (28).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 3, 6, 7, 8, 12, 39, 45 and 47-52 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over either Brinkley or Andrews.

Either one of Brinkley or Andrews (excluding claims 49 and 50) meets all of the limitations of the above claims, except the size, angle; shape; hardness; number of conditioning elements; the orientation of the plurality of conditioning elements and rod/rollers and sharpening station.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use cylindrical conditioning elements, at specific size and angle with the specific hardness, since it has been held that changing shape, dependent on work-piece

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parameters, involves only routine skill in the art. *In re Stevens*, 101 US PQ 284(CCPA1954); since it has been held that mere duplication of the essential working parts of a devise involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8; and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 49 and 50, Brinkley as modified above meets the limitations, i.e., (31, 38); support member (25, 27, 36), guide pivotally mounted to the support (38 at 34) and adjusting structure (29, 30).

Regarding claims 51 and 52, using rod/roller and duplicating the conditioning stations forming an apparatus having more than one station i.e., as evident by cite reference Friel, would meet all of the limitations.

Allowable Subject Matter

18. Claim 11 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

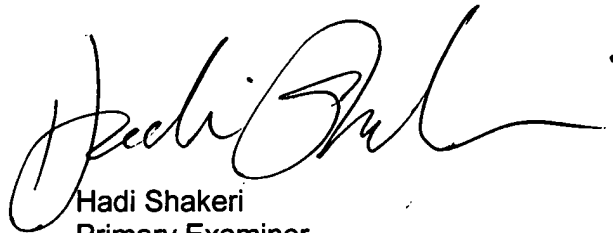
19. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Friel, Campione et al., Gangelhoff et al., McEvily, Battocchi, Cohen, and Evans are cited to show related inventions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 703-308-6279. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on 703-308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Hadi Shakeri', with a stylized flourish extending to the right.

Hadi Shakeri
Primary Examiner
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October 16, 2004